

ESTTA Tracking number: **ESTTA437783**

Filing date: **10/25/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77820105
Applicant	Ripples Group Limited
Applied for Mark	ULTRA CASE
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Submission	Appeal Brief
Attachments	FH 3117 - Appeal Brief.pdf (15 pages)(58835 bytes)
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Applicant : Ripples Group Limited
Serial No. : 77/820,105
Filed : September 3, 2009
Mark : ULTRA CASE & Device
Int. Classes: 9
Examining Attorney : RHIM, ANDREW
Law Office : 101

USPTO
TTAB
PO Box 1451
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APPLICANT'S APPEAL BRIEF

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

REMARKS

Applicant seeks to register the mark "Ultra Case & Device" (the "Mark") for "Cases and bags specially adapted for protecting, holding and/or carrying electronic devices, namely, mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; screen protectors or/and fitted plastic films for mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; devices and accessories for mobile phones, cell phones, media players, media recorders, namely, hands-free devices for mobile phones, keyboards, batteries, battery chargers" in International Class 9.

The Examining Attorney has objected to Applicant's application based on an allegedly conflicting registration, and since has refused to register the subject mark, in our opinion, incorrectly.

The Examining Attorney alleges that the Mark so resembles the mark ULTRACASE, shown in Reg. No. 3199331 ("Cited Registration"), as to be likely to cause confusion, to cause mistake, or to deceive. The Cited Registration is for "waterproof, all-environment carrying and transit cases for electronic and field instruments" in Class 9. The Cited Registration is owned by Underwater Kinetics, LP, of California.

The Applicant has presented copious amounts of materials in support of its position in this application that there is no likelihood of confusion between the Mark and the Cited Registraton. A submission of 177 pages was presented to the Examiner, with detailed arguments in opposition of Examiner's rejection.

The Applicant hereby reiterates all the arguments that were presented during the prosecution of the application for the allowance of the Mark, and against the rejection by the Examiner, as if they were presented herein.

The Applicant respectfully requests that the TTAB carefully review all the supporting materials that were submitted in the application,

For the reasons set forth below, we respectfully disagree with the Examining Attorney's position and submit that there is no likelihood of confusion between Applicant's mark and the Cited Registration.

**CONFUSION IS NOT LIKELY BETWEEN
APPLICANT'S MARK AND THE CITED REGISTRATION**

Under the Trademark Act, a refusal to register grounded on likelihood of confusion requires that confusion as to the source of the goods or services not be merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). As the Trademark Trial and Appeal Board stated in In re Mashev-Ferguson Inc., 222 U.S.P.Q. 367, 368 (T.T.A.B. 1983), quoting Witco Chemical Co. v. Whitfield Chemical Co., Inc., 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969), "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with practicalities of the commercial world, with which trademark deals."

Mere similarity between two marks will not alone serve to be determinative of likelihood of confusion. See McGregor-Doniger, Inc. v. Drizzle, Inc., 202 U.S.P.Q. 81, 89 (2d Cir. 1979). As the Court of Appeals for the Second Circuit has stated:

"First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. 'Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.'" (Citation omitted)

Id., 202 U.S.P.Q. at 89.

In the present situation, the possibility of confusion between Applicant's mark and the Cited Registration is de minimis.

We respectfully suggest that a finding of likelihood of confusion here ignores the practicalities of the commercial environment within which the respective marks are used. Likelihood of confusion does not exist here because (A) the Mark and the Cited Registration create distinct commercial impressions and are different in terms of visual appearance and sound, (B) the Mark and the Cited Registration are used on different goods, (C) the goods that are covered by the respective applicant's Mark and Cited Registration mark travel in different channels of commerce and are therefore offered to different groups of consumers, and thus confusion is unlikely, and (D) the Office has recognized that confusion is not likely by allowing registrations for numerous similarly situated marks to coexist. We submit that when the relevant factors articulated in In re E.L. DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) are applied to this case, a finding that there is no likelihood of confusion under Section 2(d) of the Trademark Act is appropriate.

A. The marks are different as to commercial impression, visual appearance and sound

When viewed in their entireties, the Mark and the Cited Registration are not confusingly similar because they create different overall commercial impressions, and are dissimilar as to visual appearance and sound.

1. The marks give different commercial impressions

The Mark and Cited Registration create very different commercial impressions.

The applied for Mark "Ultra case & Device" looks very different from the ULTRACASE Cited Registration. The former is a two-word mark that contains a design

element. The first letter looks like a capital letter U, with vertical prongs of the letter U cut thru in the middle, which makes it look like an umlaut Ü, with the letter U being encircled, and the word “case” being located underneath the word Ultra. The registered Cited Mark is a capital ULTRACASE mark, without any design elements. The Cited mark as used in commerce, however, as can be seen from the attached specimen (Exhibit A) that the registrant of ULTRACASE submitted to prove use of its mark, looks even more drastically different from the applied for Mark. The Cited Registration mark looks like “UK UltraCase” in a dark rectangle (see Exhibit A).

The applied for mark consists of two words – ultra and case, while the Cited Registration consists of one word – ULTRACASE.

The applied for mark is applied for in lower case, except for the initial letter U, while the Cited Registration is registered in capital letters.

The meaning or connotation of a mark must be determined in relation to the named goods or services. See TMEP § 1207.01(b)(v). Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, the Board finding that the term was suggestive of the construction of applicant's bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that "crosses over" the line between informal and more formal wear when applied to ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held

not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color and durability adapted to outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats and trousers, but does not have this connotation when applied to ladies' and children's underwear).

The subject applicant's Mark "Ultra case & Device" is applied for in respect of Cases and bags specially adapted for protecting, holding and/or carrying electronic devices, namely, mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; screen protectors or/and fitted plastic films for mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; devices and accessories for mobile phones, cell phones, media players, media recorders, namely, hands-free devices for mobile phones, keyboards, batteries, battery chargers.

Thus, the applied for goods are primarily cases for protecting electronic devices, such as telephones, skins for covering mobile phones, etc., as can be seen from attached images provided by the applicant (Exhibit B). The provided images show small thin plastic covering skins that are used on Apple Computer iPhone's to protect them from scratching.

To the contrary, the goods that are sold by the Registrant, the owner of ULTRACASE Cited Registration are big sturdy carrying boxes for carrying various items and for protecting them dust and water, as is shown in printouts taken from Registrant's website www.uwkinetics.com. (Exhibit C.) The huge carrying cases that are shown on the Registrant's websites are goods that are very different from Applicant's goods.

The Cited Registration evokes a commercial impression that is wholly distinct from that of the Mark.

2. The marks are different as to sight

The two marks are different as to sight.

The applied for mark consists of two words – ultra and case, while the Cited Registration consists of one word – ULTRACASE.

The applied for mark is applied for in lower case, except for the initial letter U, while the Cited Registration is registered in capital letters.

3. The marks must be compared in their entirety

It is inappropriate to take the applied for mark as being the same “ultracase” mark as the registered ULTRACASE mark.

The Examiner must compare the marks in their entirety, with their design elements together, and not to concentrate on word elements only.

As stated by the Court in Massev Junior College, the subject marks must be viewed in their entirety and not dissected:

That marks must be considered in their entirety in determining whether there is a likelihood of confusion or mistake is a basic rule in comparison of marks. Here the Board . . . sought to establish

an exception to the rule, namely: if the most prominent feature of a mark creates a commercial impression separate and apart from the remaining features of the mark, any confusing similarity with respect to it is determinative with respect to the mark in its entirety. We know of no authority which supports such an exception and hold that the Board erred on this point.

Massev Junior College v. Fashion Institute of Technology. 492 F.2d 1399, 181 U.S.P.Q. 272, 273-74 (C.C.P.A. 1974).

There is substantial precedent to support the rule that potentially conflicting marks should be compared in their entireties and not dissected into component parts to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer that is important. In re Hearst Corp., 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992) (Fed. Cir. reversed T.T.A.B. decision finding that VARGA GIRL likely to be confused with VARGAS); In re Nat'l. Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) ("basic principle in determining confusion between marks is that marks must be compared in their entireties. . ."); Q.& W. Thum Co. v. Dickinson, 245 F. 609 (6th Cir. 1917), cert. denied, 246 U.S. 664, 62 L.Ed. 928, 38 S.Ct. 334 (1918); Massev Junior College Inc. supra, 492 F.2d 1399; Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 4 U.S.P.Q. 2d 1942 (6th Cir. 1987); Estate of P.P. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538 (1920)

This "anti-dissection" rule is based upon the assumption that an average purchaser retains a mental impression of a trademark in its totality. T & T Mfg. Co. v.

A.T. Cross Co., 449 F. Supp. 813, 197 U.S.P.Q. 763 (D.C.R.I. 1978), *affd*, 587 F.2d 533, 201 U.S.P.Q. 561 (1st Cir. 1978), *cert denied*, 441 U.S. 908, 60 L.Ed.2d 377, 99 S.Ct. 2000, 202 U.S.P.Q. 320 (1979). Further, it has been held to be a violation of this long-standing rule to focus on a "prominent" feature of a mark and decide likely confusion solely on that feature, ignoring all other elements of the mark. Massev Junior College, *supra*.

It is inappropriate to dissect the Mark in the manner relied on by the Examining Attorney when claiming that the marks are the same just because they have similar word elements, without giving appropriate weight to the design element of the applied for mark.

B. The Mark and the Cited Registration are used on different goods

The subject applicant's Mark "Ultra case & Device" is applied for in respect of Cases and bags specially adapted for protecting, holding and/or carrying electronic devices, namely, mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; screen protectors or/and fitted plastic films for mobile phones, cell phones, smart phones, portable telephones, media players, media recorders, audio players, audio recorders, movie players, movie recorders; devices and accessories for mobile phones, cell phones, media players, media recorders, namely, hands-free devices for mobile phones, keyboards, batteries, battery chargers.

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Thus, the marks are used on different goods, and thus, confusion among the consumers is highly unlikely.

C. The goods that are covered by the respective applicant's Mark and Cited Registration mark travel in different channels of commerce and are therefore offered to different groups of consumers, and thus, confusion is unlikely.

Applicant's goods are skins and protective covers for small electronic devices like iPhones. Registrant's goods are big sturdy carrying boxes for various items that serve to protect such items hermetically from water and dust. The items of both

applicant and registrant are presumably sold in different stores and are offered to different public. Thus, confusion is unlikely.

D. The Office Has Consistently Allowed Similarly Situated Marks to Coexist

The Applicant notes that the Office has allowed multiple registrations that incorporate the same common element of the marks to coexist with each other on the Principal Register for goods no less similar to each other than those of the Cited Registration and the Mark. For example, numerous marks incorporating the word "ULTRA" coexist on the Principal Register for related goods in International Class 009, including ULTRA (Reg. No. 2980999 for computer software in IC 009), ULTRA (Reg. No. 3122296 for computer software for complete supply chain management in oil companies, among other goods, in IC 009), ULTRA (Reg. No. 3310425 for computers, computer data storage devices, among other goods, in IC 009), ULTRA (Reg. No. 3310244 for notebook computer batteries, among other goods, in IC 009). Printouts of the registration information for these marks are attached hereto as Exhibit D.

These concurrently existing registrations demonstrate that the Office has in the past recognized the commercial reality that consumers frequently encounter multiple marks incorporating similar marks and are therefore unlikely to be confused by the coexistence of multiple marks featuring similar word elements when other distinguishing elements are present. The coexistence of Applicant's Mark and the Cited Registration on the Principal Register is similarly unlikely to confuse consumers, particularly in light of the significant points of difference described herein, including the difference in the goods covered by the two marks.

ADDITIONAL ARGUMENT AGAINST LIKELIHOOD OF CONFUSION REJECTION

In addition to earlier arguments that applicant submitted in opposition to Examiner's likelihood of confusion rejection, applicant repeats all previously submitted arguments, and adds the following arguments:

Attached evidence shows that the applicant's mark and registrant's mark are used on very different goods. Applicant's goods are primarily cases, covers and skins for light small electronic devices – portable phones such as iPhones and small portable music players such as iPods. These devices are light and designed to be carried on one's person. They are of many bright colors and patterns. The attached snap of registrant's website shows that registrant's goods are sturdy "transit" cases for carrying "field instruments". Those goods are big sturdy goods are presumably used for shipping or transporting in transit bulky industrial size equipment. Thus, the users of the respective goods are different.

Furthermore, the applicant is a Hong Kong company and offers its goods online, on its website (evidence of what the website looks like is attached). Since US consumers can only purchase applicant's goods online, not in stores, and the website of applicant looks different to website of registrant, there cannot be likelihood of confusion. The public is not buying these goods in the same store. Reasonable consumer can tell a difference between two websites and conclude that they come from different companies.

The marks are visually different. The main element of applicant's mark is an encircled U with umlaut. It looks very different from block letters of ULTRACASE.

The Examiner did not demonstrate any prima facie evidence of actual confusion. To the contrary, the attached evidence suggests that there is no confusion among the public. Both parties are using the marks in the US in the marketplace and there is no confusion. There is no adverse impact on registrant.

Therefore, please withdraw the finality of your objections and approve the application for registration.

Attached is various evidence of use of the applicant's mark in commerce, and other materials, namely:

1. Copies of Trademark Certificate or filing receipt of Trademark registrations / applications in the following countries/regions:

- Hong Kong (certificate)
- Community Trademark (European) (certificate)
- Japan (certificate)
- PRC (filing receipt)

2. Copies of Authorized Resellers Agreement in US market

3. Copies of invoices made to clients in US

4. Paypal payment records by the re-sellers and customers
5. Image of pdf capture of Applicant's Homepage of our client's website for "Ultra Case" and its captures
6. Google ad-words campaign records for the word "Ultra-case" (website banners statistics in Canada and US)
7. Copies of MacWorld US magazine advertisement (Issues Nov, Dec 2009; Feb, Mar, Apr, May Jun, Aug 2010)
8. Copies of MacWorld AU magazine advertisement (Issue Feb 2010)
9. Product catalogue leaflet and product catalogue of "Ultra Case"

CONCLUSION

In view of the foregoing, Applicant respectfully submits that there is no likelihood of confusion between its Mark and the Cited Registration and requests that Applicant's application be approved for publication and allowance.

Respectfully submitted,

By /Sergei Orel/

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Date: 25 October 2011